

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL J. SCHELLINGER and ROBERT F. D'AVELLO

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Appeal No. 1999-0876  
Application No. 08/693,494

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ON BRIEF

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Before FLEMING, RUGGIERO, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 20, which are all of the claims pending in this application.

Appellants' invention relates to a method for establishing a communication link between a cordless base station and authorization equipment. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for establishing a communication link between a cordless base station and authorization equipment, said cordless base station being coupled to a telephone network and

Appeal No. 1999-0876  
Application No. 08/693,494

being adapted to communicate with a wireless communication device, the method comprising the steps of:

(i) transmitting a connect message from said authorization equipment to said cordless base station, said connect message having a first random number;

(ii) generating an authentication message having an identification code associated with said cordless base station and a cordless base station authentication result in response to said connect message; and

(iii) transmitting said authentication message from said cordless base station to said authentication equipment.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Breeden et al. (Breeden)	5,202,912	Apr.
13, 1993		
Connolly et al. (Connolly)	5,325,419	Jun. 28,
1994		

Claims 1 and 3 through 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Breeden.

Claims 1, 11, 12, and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Connolly.

Claims 3 through 9, 13 through 16, and 18 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Connolly.<sup>1</sup>

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<sup>1</sup> We note that on pages 2 and 11 of the Answer the examiner indicates that the rejection of claims 1 and 3 through 20 under 35 U.S.C. § 102(f) has been withdrawn. Also, on page 11 of the Answer, the examiner indicates that

Appeal No. 1999-0876  
Application No. 08/693,494

Reference is made to the Examiner's Answer (Paper No. 19, mailed October 1, 1998) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 18, filed August 5, 1998) for appellants' arguments thereagainst.

#### OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the anticipation rejection of claims 1 and 3 through 20 over Breeden; the anticipation rejection of claims 1, 11, 12, and 17 over Connolly; and the obviousness rejection of claims 3 through 9, 13 through 16, and 18 through 20.

The examiner first rejects all of the claims as being anticipated by Breeden. "It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." In re King,

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the terminal disclaimer filed on August 5, 1998 has been accepted, and the examiner omits from the Answer the obviousness-type double patenting rejection made in the Final Rejection. Accordingly, we assume that the terminal disclaimer has overcome the obviousness-type double patenting rejection, and, therefore, that rejection is not before us.

Appeal No. 1999-0876  
Application No. 08/693,494

801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). See also Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick,

730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

The examiner (Answer, page 4) asserts that Breeden discloses a method which establishes a communication link between a cordless base station TBS-1 and authorization equipment CPP-1. However, CPP-1 is the cordless telephone portion of a telephone handset, not authorization equipment. Further, even if one were to consider CPP-1 authorization equipment, each of independent claims 1, 11, and 12 recites that the connect message has a first random number, and independent claims 3, 11, and 17 recite that the authentication request has a random number generated at the cordless base station. We find no teaching of any generation of random numbers in Breeden, and the examiner points to none. In fact, the examiner has apparently disregarded these limitations in rejecting the claims over Breeden. Thus, Breeden fails to disclose each and every element of each of the independent claims. Accordingly, we cannot sustain the anticipation rejection of claims 1, 3, 11, 12, and 17, nor of their

Appeal No. 1999-0876  
Application No. 08/693,494

dependents, claims 4 through 10, 13 through 16, and 18 through 20.

Next the examiner rejects claims 1, 11, 12, and 17 under 35 U.S.C. § 102(e) as anticipated by Connolly. Appellants contend (Brief, page 4) that Connolly does not disclose "generating an authentication message . . . having a cordless base station authentication result," as recited in independent claims 1 and 12. The examiner does not reply to this argument. We agree with appellants. Connolly is directed to authenticating the portable handset, not the base station. Therefore, the authentication result is not a cordless base station result, but, rather, a portable handset result. In addition, Connolly does not send a connect message to the base station, as recited in independent claims 1, 11, and 12, but, rather, sends an authentication request message to the handset through the base station. Consequently, Connolly fails to meet each and every limitation of claims 1, 11, and 12, so we cannot sustain the anticipation rejection of claims 1, 11, and 12 over Connolly.

In addition, appellants argue (Brief, page 5) that Connolly "discloses transmitting a random number generated at

a handset by way of a base station, not 'a second random number generated at said cordless base station' as claimed" in independent claims 11 and 17. The examiner admits (Answer, page 6) that Connolly fails to disclose a random number generated at the cordless base station, as this is the examiner's basis for rejecting other claims under 35 U.S.C. § 103 instead of under 35 U.S.C. § 102. Thus, we are a bit confused as to why claims 11 and 17 were not included with the claims rejected for obviousness over Connolly. Nonetheless, as the rejection before us is under 35 U.S.C. § 102, and Connolly fails to disclose each and every element of claims 11 and 17, we cannot sustain the rejection of claims 11 and 17 over Connolly.

Regarding the obviousness rejection of claims 3 through 9, 13 through 16, and 18 through 20 over Connolly, the examiner asserts (Answer, page 6) that Connolly discloses all of the claimed subject matter except for a random number generated at the cordless base station. We first note that claims 4, 6, 7, 13, 15, and 16 do not include the limitation of a random number generated at the cordless base station. Instead, as asserted by appellants (Brief, pages 6-7), claims

Appeal No. 1999-0876  
Application No. 08/693,494

4 and 13 recite "transmitting an authentication request from said cordless base station to said authorization equipment" and claims 6, 7, 15, and 16 recite "generating an authentication result," neither of which is taught by Connolly. The examiner fails to respond to this argument, and thus provides no guidance.

In Connolly (column 19, lines 23-28), the base station requests authentication from the public switched telephone network, not the service control point (which the examiner points to as the authorization equipment). Further, the service control point (or the authorization equipment) does not generate any authentication result. Therefore, Connolly fails to disclose each and every element of claims 4, 6, 7, 13, 15, and 16, and the examiner has provided no motivation for modifying Connolly to include the limitations found lacking from the reference. Accordingly, the examiner has failed to establish a *prima facie* case of obviousness, so we cannot sustain the rejection of claims 4, 6, 7, 13, 15, and 16.

Claims 3, 5, 8, 9, 14, and 18 through 20 do include the limitation of a random number generated at the cordless base

station. The examiner states (Answer, pages 6-7) that Connolly discloses transmitting a second random number RES1 from the cordless base station to the authentication equipment and that "[i]t would have been obvious . . . to move the generation of the random number from the wireless communication device of **Connolly, et al** to the cordless base station, in order to make the wireless communication less complicated and less expensive." As an alternative motivation for modifying Connolly, the examiner asserts that "it has been held that rearranging parts of an invention involves only routine skill in the art."

As to the examiner's first attempt at modifying Connolly to include a second random number generated at the base station, the examiner provides no evidence or basis in the reference for his conclusion of obviousness. The Court has held that "[w]ith respect to core factual findings in a determination of patent-ability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense." *In re Zurko*,



Appeal No. 1999-0876  
Application No. 08/693,494

No. 96-1258 (Fed. Cir. August 2, 2001). Thus, we will not accept as motivation for modifying Connolly bald assertions with no evidence to support them.

Further, regarding the obviousness of "rearranging parts of an invention," Connolly generates the second random number at the handset because it is the handset which is being authenticated. Changing the generation of the second random number to the base station would not merely be a rearrangement of parts, but, rather, would destroy the operation of Connolly's system. The Federal Circuit has held that "a proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)." *In re Fritch*, 972 F.2d 1260, 1265-1266 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992). Therefore, as we cannot accept either of the examiner's reasons for modifying Connolly, the examiner has failed to establish a *prima facie* case of obviousness. Consequently, we cannot sustain the obviousness rejection of claims 3, 5, 8, 9, 14, and 18 through 20.

#### CONCLUSION

Appeal No. 1999-0876  
Application No. 08/693,494

The decision of the examiner rejecting claims 1 and 3 through 20 under 35 U.S.C. § 102(b) over Breeden; claims 1, 11, 12, and 17 under 35 U.S.C. § 102(e) over Connolly; and claims 3 through 9, 13 through 16, and 18 through 20 under 35 U.S.C. § 103 over Connolly is reversed.

REVERSED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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Appeal No. 1999-0876  
Application No. 08/693,494

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